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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,281	03/14/2001	Robert W. Thomson	102115-200	4268
27267	7590	09/19/2005	EXAMINER	
WIGGIN AND DANA LLP ATTENTION: PATENT DOCKETING ONE CENTURY TOWER, P.O. BOX 1832 NEW HAVEN, CT 06508-1832			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/808,281	Applicant(s) THOMSON ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-28, 30-34, drawn to a method<sup>1</sup> to provide customer warranty support and repair services via a computer network, classified in class 707, subclass 100+.
  - II. Claim 29, drawn to a method<sup>2</sup> for repairing a defective product, classified in class 705, subclass 26, 27.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation resulting in different effects and are not capable of use together.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Attorney Gregory Rosenblatt on 9/13/05 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-28, 30-34. Affirmation of this election must be made by applicant in replying to this Office action. Claim 29 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. Claims 1-28, 30-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 1 is vague because the preamble mentions "repair service" but there is no discussion with respect to this item in the body of the claim. It's not clear whether this limitation is part of the boundary of the scope of the claimed invention.

2) Claim 1 is a method claim but fails to include active/positive method steps to carry out the scope of the invention. The claim is written to contain discrete elements like an apparatus claim which is improper for a method claim. Correction is recommended.

3) In claim 1, the phrase "a personalized portion" is vague and indefinite and should be changed to "information or data".

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**10. Claim 1–28, 30–34 are rejected under 35 U.S.C. 103(a) as being unpatentable over SEAGATE article (Nov. 18, 1997) alone or further in view of COSTIN, IV et al (US 2002/0049816) or MILLER et al (US 2001/0051875).**

As for independent method claim 1, SEAGATE article fairly discloses a method to provide customer warranty support and repair services via a computer network, comprising:

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(a) at least a database accessible via said computer network (online service) by a plurality of customers, said at least one database {"company's database"} including a personalized portion for each one of the plurality of customers that request warranty support, the personalized portion including customer data necessary from a manufacturer to provide warranty support of products sold by said manufacturer;

(b) said at least database accessible to a plurality of said manufacturers via said computer network, including a personalized portion for each one of the plurality of manufacturers containing warranty information regarding products sold by said manufacturers, and customers that request warranty support, the personalized portion including customer data necessary from a manufacturer to provide warranty support of products sold by said manufacturer {see page 1 of the article}.

As for the limitation of at least first database and at least a second database, the use of two or more databases to achieve similar results as in one database is merely considered as making separable of similar parts to achieve separable similar results and this would have been obvious to a skilled artisan as routine experimentation for selective results, absent evidence of unexpected results. See In re Lindberg, 93 UQ 23, In re Larson et al, 144 UQ 347.

As for the limitation "or manufacturer authorized seller", this is considered as option or second option for selling the products. The examiner takes the 1<sup>st</sup> option which wherein the "products sold by said manufacturer".

As for the limitation of "a warranty administrator" interfacing with the customers and manufacturers, this is inherently included in the teaching of SEAGATE article

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wherein an administrator/manager is normally set up to handle the warranty and customer services apart from the manufacturing areas.

COSTIN, IV et al is cited to teach the use of 3<sup>rd</sup> party or independent administrator to handle the interaction between customers and companies/suppliers or other related organization and wherein several databases containing data with respect to the customers or organizations are maintained by the administrator/3<sup>rd</sup> party for efficient accessing through the Internet with interactive participation of all parties involved {see Fig. 1a, 18, 26, 24, 12, 10, 20, [0006, 0007, 0061]}. It would have been obvious to modify the process of SEAGATE article by using a 3<sup>rd</sup> party or independent administrator to handle the interaction between customers and companies/suppliers or other related organization and wherein several databases containing data with respect to the customers or organizations are maintained by the administrator/3<sup>rd</sup> party for efficient accessing through the Internet with interactive participation of all parties involved.

MILLER et al is cited to teach the use of 3<sup>rd</sup> party or independent administrator to handle the interaction between customers and companies/suppliers or other related organization and wherein several databases containing data with respect to the customers or organizations are maintained by the administrator/3<sup>rd</sup> party for efficient accessing through the Internet with interactive participation of all parties involved {see Fig. 1 (13, 14, 11, 12, [0006, 0007]}. It would have been obvious to modify the process of SEAGATE article by using a 3<sup>rd</sup> party or independent administrator to handle the interaction between customers and companies/suppliers or other related organization

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and wherein several databases containing data with respect to the customers or organizations are maintained by the administrator/3<sup>rd</sup> party for efficient accessing through the Internet with interactive participation of all parties involved.

As for dep. claim 2 (part of 1), which deals with the optional limitation or with 2<sup>nd</sup> option deals with the "seller", this is an option thus carrying no patentable weight since the examiner takes the 1<sup>st</sup> selection or "by the manufacturer".

As for dep. claims 3-28, 30-34 (part of 1), which depend on dep. claim 2 above, they are rejected for the same reason set forth in dep. claim 2 above. In other word, these are optional and thus carrying no patentable weight. Moreover, these are merely well known online interactive communication parameters for warranty verification, i.e. online repair order and a confirmation number, and are inherently included in SEAGATE article /COSTIN, IV et al or would have been obvious to a skilled artisan as routine experimentations, absent evidence of unexpected results.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Article "Hyundai uses the Internet to increase parts sales at dealership".

2) Article "Dell Takes .. Consumer Portal", teaches online communication for warranty services and repairs as in the claimed invention.

3) Article "Opinions ... Waste away", teaches the use of warranty administrator to handle communications between suppliers and customers.

No claims are allowed.



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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

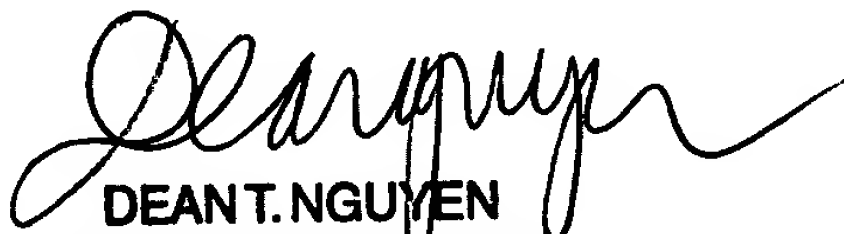
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
September 12, 2005

  
DEAN T. NGUYEN  
PRIMARY EXAMINER